

REMARKS

In response to the Office Action mailed on July 21, 2005, Applicant respectfully requests reconsideration based on the above claim amendments and the following remarks. Applicant respectfully submits that the claims as presented are in condition for allowance.

Claims 1, 16, 18, 21, 25, and 26 have been amended, Claims 6-8, 10-11, 17, and 28 have been canceled, and new Claims 33-37 have been added, leaving Claims 1-5, 9, 12-16, 18-27, 29-37 for consideration upon entry of the present amendment. The paragraph [0031], page 11 of the specification discusses the features of Claims 1, 18, 21, 25, and 26. The paragraph [0035], page 13 of the specification discusses the features of new Claims 33-37. No new matter has been added by the amendments.

Claim Rejections Under 35 U.S.C. § 102(e)

Claims 1, 18, 21, and 25-31 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Sandegren, U.S. Patent No. 6,512,930 (hereinafter "Sandegren"). Since Claim 28 has been canceled without prejudice, the rejection of Claim 28 is moot.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."
Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Claim 1 recites a method for providing a mobile network notification service comprising: establishing a notification list associated with a first notification service customer; adding a second notification service customer to said notification list in response to a request of said first notification service customer and a permission code of said second notification service customer entered by said first notification service customer; receiving a first telephone number associated with said first notification service customer; receiving an indication that a first telephone corresponding to said first telephone number has been powered on and is available in a mobile network; determining a mobile network status of a second telephone corresponding to a second telephone number associated with said second notification service customer in response to locating

said second telephone number in said notification list associated with said first notification service customer; and transmitting said status to said first notification service customer.

In contrast, Col. 7, lines 35-39 of Sandegren teaches that the system can provide security/confidentiality by giving each mobile subscriber the choice of being on another user's "Notify Me" list or not; and the default can be set to "not permitting listing on another user's list". Sandegren fails to teach or suggest the element "adding a second notification service customer to said notification list in response to a request of said first notification service customer and a permission code of said second notification service customer entered by said first notification service customer", as recited in Claim 1.

Since they contain similar features, Claims 18, 21, 25, and 26 are patentable over Sandegren for at least the reasons given for Claim 1. Claims 27, 29, 30, and 31 depend from Claim 26, and thus are believed to be allowable due to their dependency on Claim 26.

Claim Rejections Under 35 U.S.C. § 103(a)

Claims 2-5, 9, 12-17, 19-20, 22-24, and 32 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Sandegren. Since Claim 17 has been canceled without prejudice, the rejection of Claim 17 is moot.

For an obviousness rejection to be proper, the Examiner must meet the burden of establishing that all elements of the invention are disclosed in the prior art; that the prior art relied upon, coupled with knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference or combined references; and that the proposed modification of the prior art must have had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the time the invention was made. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); *In Re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970).

As stated above, Sandegren does not render Claim 1, from which Claims 2-5, 9, and 12-16 depend, because it fails to teach or suggest all of the elements of Claim 1.

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Therefore, Claims 2-5, 9, and 12-16 are patentable over Sandegren due to their dependency on Claim 1. Claims 18, 21, and 26 are patentable over Sandegren for at least the reasons given for Claim 1. Claims 19-20 depend from Claim 18; Claims 22-24 depend from Claim 21; and Claim 32 depends from Claim 26. These claims are patentable over Sandegren due to their dependency on Claims 18, 21, and 26, respectively.

New Claims

New Claim 33 includes all of the elements of Claim 1 and further recites determining the most recent geographic location of said second telephone when said second notification service customer is not active and transmitting said most recent geographic location to said first notification service customer. Any of Sandegren, Simpson, U.S. Publication No. 2005/0004984, and Trandal et al., U.S. Patent No. 6,738,461 does not teach or suggest the elements of Claim 33. Therefore, Claim 33 is patentable over the references. Since they contain similar features, Claims 34-37 are patentable.

If there are any charges with respect to this response or otherwise, please charge them to Deposit Account 06-1130 maintained by Applicants' attorneys.

Respectfully submitted,

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